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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,219	04/13/2004	Robert C. Richardson	3287	9067
26645 7590 12/18/2009 THE LUBRIZOL CORPORATION ATTN: DOCKET CLERK, PATENT DEPT. 29400 LAKELAND BLVD. WICKLIFFE, OH 44092				
EXAMINER ALEXANDER, LYLE				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
12/18/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/823,219

Applicant(s)

RICHARDSON ET AL.

Examiner

LYLE A. ALEXANDER

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 23-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-14 and 22-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1 and 23 claim "fuels" which is vague and indefinite what is type of material is intended. The claimed "fuels" is sufficiently broad to encompass anything that will burn. This includes solid, liquid and gaseous materials. For the purposes of examination, it will be assumed than any organic fluid, such as "machining fluids ... lubricant ... extreme pressure agents" can be interpreted as a "fuel" because these materials are combustible and could be used as a heating. Clarification could be achieved by deleting "fuels".

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-8 and 10-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Becket.

See the appropriate paragraph of the 8/6/09 Office action for the teachings of Becket.

In light of the above 35 USC 112 second paragraph issues, the claimed "fuel" is sufficiently broad to have been properly read on the taught "machining fluids ... lubricant ... extreme pressure agents".

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-8 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becket.

In light of the above 35 USC 112 second paragraph issues, the claimed "fuel" is sufficiently broad to have been properly read on the taught "machining fluids ... lubricant ... extreme pressure agents". However, even if "fuels" were deleted or the BPAI were to disagree with the interpretations of "fuels" of record, the Office will maintain the below rejections:

See the appropriate paragraph of the 8/6/09 Office action for the teachings of Becket.

3. Becket teaches in column 14 lines 4-31 the testing of "machining fluids ... lubricant ... extreme pressure agents", but is silent to the claimed functional fluids.
4. The court decided it is "obvious to try" when choosing from a finite number of predictable solutions. It would have been within the skill of the art to use a well known test device, such as that of Becket, to test other types of lubricants, such as transmission fluids and/or hydraulic fluids. Additionally, it would have been within the skill of the art to use any well known device for the testing of organic compounds, such

as that of Becket, to test other organic compounds, such as transformer fluids, fuels, diesel, gasoline, biofuels and mixtures thereof.

5. It would have been within the skill of the art to modify the method taught by Becket and apply the same method to other types of organic fluids, such as the claimed transmission fluids, hydraulic oils, transformer fluids, fuels, diesel, gasoline, biofuels and mixtures thereof as "obvious to try" as explained above.

Allowable Subject Matter

6. If the above 35 USC 112 second paragraph issues are resolved, claims 23-24 will be in condition for allowance. Additionally, claim 9 would be objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: In addition to the remarks of record, the closest cited prior art Becket, does not teach or suggest the method of claim 23 that test a function fluid with the claimed indicators. Pickup and Mlinar et al. fail to teach the claimed method of using a test medium comprising polymeric fibers and the claimed indicators.

Response to Arguments

8. Applicant's arguments filed 9/28/09 have been fully considered but they are not persuasive.

9. Applicants' traverse the 35 USC 102 rejections stating Becket fails to teach the claimed functional fluids. The Office notes the new 35 USC 112 second paragraph

rejections and maintains the position the claimed "fuels" are sufficiently broad to have been properly read on the materials taught by Becket. Additionally, the Office maintains that even if "fuels" could not be read on Becket, it would have been within the skill of the art under 35 USC 103 to have used a known test device for other materials, such as those claimed.

10. With respect to new claim 23, Applicants' correctly stating the cited prior art fails to teach a method using the claimed indicators. The Office has indicated that claims 23-24 would be allowable if the 35 USC second paragraph rejections are overcome by removing "fuels" from the list of functional fluids.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LYLE A. ALEXANDER whose telephone number is (571)272-1254. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LYLE A ALEXANDER/
Primary Examiner, Art Unit 1797
11.